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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,676	04/09/2001	Steven V. Kauffman	SVL920010029US1	1588
23373	7590	08/11/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			SHIBRU, HELEN	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,676

Applicant(s)

KAUFFMAN ET AL.

Examiner

SHIBRU HELEN

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-24 is/are rejected.
7) ☒ Claim(s) 8, 16, 24 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date July 16 2001.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

Drawings

1. The drawings are objected to because figures 1, 2A, 3-5, 6A and 7 are shaded. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 2 is objected to because of the following informalities: the word “marker” should be “mark”. Appropriate correction is required.
3. Claim 17 is objected to because of the following informalities: In line 3 the phrase “an first software” should be “a first software”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8, 16, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims should state as ‘...wherein the second content has a second format different than the first format.’ Appropriate correction required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17, 20 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are computer related processes which do not have any physical transformation outside the computer nor be limited to a practical application.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-4, 9-12 and 17-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 25-26 and 13-14, respectively of U.S. Patent No. 6,870,887 in view of Mills (US Pat. No. 5,237,648).

Regarding claims 1-4, 9-12 and 17-20, the subject matter in these claims can be found in claims 1-2, 25-26 and 13-14 of patent No. 6,870,887, respectively. However patent 6,870,887 fails to teach building a list comprising a starting mark and ending mark for each selected portion of first content, the list for use in accessing corresponding portions of the same content stored as second content in a second format.

In the same field of endeavor, Mills teaches building a list comprising a starting mark and ending mark for each selected portion of first content, the list for use in accessing corresponding portions of the same content stored as second content (see fig.2 clip edit (22) in a second format; edit window (38) and col. 4 line 59-col. 5 line 7). Therefore it would have been obvious to one skill in the art at the time the invention was made to modify Kauffman using Mills in order to edit portions of video information.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Mills (US Pat. No. 5237648).

Regarding claim 1, Mills discloses a method for specifying a selection of content segments stored in different formats, comprising the steps of:

receiving specification of a plurality of portions (see fig. 2 clip edit window (22)) of first content; (video frame (36)) stored in a first format (see fig. 2 in video window (20), and col. 4 lines 29-46),

the specification identifying beginning and ending frames for each portion (see col. 4 lines 29-54); and

building a list comprising a starting mark and ending mark for each selected portion of first content, the list for use in accessing corresponding portions of the same content stored as second format (see fig.2 clip edit (22) in a second format; edit window (38) and col. 4 line 59-col. 5 line 7).

Regarding claim 2, Mills discloses the starting mark and ending mark further comprise frame numbers (it is inherent that the begin and end frames have numbers, see col. 6 lines 12-18).

Regarding claim 8, the examiner read claim 8 as the second content has a second format different than the first format. Mills discloses the second content has a second format different than the first format (it is inherent that the frames in clip edit window (22) have different resolution than frames in video frame (36) see col. 4 lines 35-46).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-7, 11-15, and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills in view of Fujita (US Pat. No. 6321024).

Regarding claims 3 and 4, claims 3 and 4 differ from Mills in that the claims further require the step of converting the starting mark and ending mark into timecodes, and the first content includes timecodes superimposed on its frames further comprising the step of first determining a correspondence between frame numbers and timecodes of the first content and using the determined correspondence to convert the starting mark and ending mark into timecodes. Mills does not disclose the step of converting the starting mark and ending mark into timecodes, however, Mills disclose the user has the ability to create new points using frame numbers (see col. 1 lines 45-53).

In the same field of endeavor, Fujita discloses the first content includes timecodes superimposed on its frames (see col. 8 lines 22-32). Fujita further discloses the starting mark and ending mark are converted into timecodes (see col. 11 lines 49-60). Therefore, in light of the teaching in Fujita it would have been obvious to one of ordinary skill in the art to modify Mills by converting starting and ending to timecodes and to superimpose timecodes on its frames in order to display the frame in a time form.

Regarding claim 5, claim 5 differs from Mills in that the claim further requires the starting mark and the ending mark further comprise timecodes. Mills does not disclose the starting mark and the ending mark comprise timecodes, however, Mills discloses begin and end points are created using small digitized frames (SDF) (see col. 2 lines 24-44).

In the same field of endeavor, Fujita discloses the starting mark (see fig. 3 in frame (317)) and the ending mark (see fig. 3 out frame (319)) further comprise timecodes (see fig. 3 frame number display box (318) and (320) and col. 13 lines 3-10). Fujita further discloses frame numbers or timecodes are allocated to the frames of the video images (see col. 8 lines 22-32). Therefore in light of the teaching in Fujita, it would have been obvious to one of ordinary skill in the art to modify Mills by providing timecodes for starting and ending marks in order to associate timecodes corresponding to the frames (see col. 9 lines 11-19).

Regarding claim 6, Fujita discloses the timecodes are extracted from the first content (see col. 12 lines 16-18 and col. 9 lines 11-19).

Claim 7 is rejected for the same reason as discussed in claim 4 above.

Claims 11, 12, 15, 19, 20 and 23 are rejected for the same reason as discussed in method claims 3 and 4 above.

Claims 13 and 21 are rejected for the same reason as discussed in method claim 5 above.

Claims 14 and 22 are rejected for the same reason as discussed in method claim 6 above.

12. Claims 9-10, 16-18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills.

Regarding claims 9-10, 16-18, and 24 the limitations in these claims can be found in the method claims 1-2, and 8. However claims 9-10, 16-18, and 24 further requires a program product containing instructions causing the computer to execute steps as claimed in claims 1-2, and 8. Official notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Mills by having a program product of being read by a computer tangibly embodying a program causing the computer to execute the steps of the method claims. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yonemitsu (US Pat. No. 5,596,565) discloses a recording format for an optical disk.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIBRU, HELEN whose telephone number is (571) 272-7329.

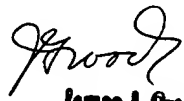
The examiner can normally be reached on M-F, 8:30AM-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, NGOC Y, VU can be reached on 571 272 7320. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru
August 5th 2005


James J. Groody
Supervisory Patent Examiner
Art Unit ~~262~~ 2616